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Docket No. 62530-A/JPW/AJZAG

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Charles S.H. Young and Peter J. Hoey

Serial No.: 09/904,669

Examiner: Myron G. Hill

Filed : July 13, 2001

Group Art Unit: 1648

For : MODIFIED ADENOVIRUS AND USES THEREOF

1185 Avenue of the Americas
New York, NY 10036
January 6, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

COMMUNICATION IN RESPONSE TO
DECEMBER 15, 2003 NOTICE OF NON-COMPLIANT AMENDMENT

This Communication is submitted in response to the December 15, 2003 Notice of Non-Compliant Amendment issued by the United States Patent and Trademark Office in connection with the above-identified application. A copy of the Notice is attached hereto as **Exhibit A**. A response to the December 15, 2003 Notice is due on January 15, 2004. Accordingly, this Communication is being timely filed.

On April 14, 2003, applicants timely filed an Amendment In Response To January 14, 2003 Office Action. The April 14, 2003 Amendment was received on April 21, 2003 in the U.S. Patent and Trademark Office. On September 5, 2003, Examiner Myron Hill of the U.S. Patent Office telephoned Alan J. Morrison, Esq., the undersigned attorney, inquiring whether a response to the January 14, 2003 Office Action had been filed, and further requested that, for his convenience, a copy of the April 14, 2003 Amendment be forwarded to him via facsimile along with a copy of the self-addressed stamped returned

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postcard. Applicants forwarded these items to the Examiner by facsimile on September 5, 2003.

A Notice of Non-Compliant Amendment was subsequently issued from the Patent Office on December 15, 2003. The December 15, 2003 Notice states that the Amendment "filed" on September 5, 2003 in connection with the above-identified application is considered non-compliant as it failed to meet the requirements of 37 C.F.R. §1.121, as amended on June 30, 2003. During a January 5, 2004 telephone conference between Examiner Hill and Aude Gerspacher, Esq. of the undersigned attorney's office, Examiner Hill conceded that the Notice of Non-Compliant Amendment was issued in error, since the Amendment was in fact filed prior to June 30, 2003, and the September 5, 2003 facsimile transmittal does not constitute the filing of an Amendment. Nevertheless, the Examiner requested that applicants submit a response to the Notice indicating same, since the Examiner is not at liberty to issue another communication withdrawing the December 15, 2003 Notice.

Accordingly, in response to the Notice, applicants maintain that the Notice of Non-Compliant Amendment was issued in error. Applicants note that the April 14, 2003 Amendment constitutes a proper response in compliance with the requirements of 37 C.F.R. §1.121 in effect on that date. Applicants further note that the copy of that Amendment faxed to Examiner Hill on September 5, 2003 does not constitute a submission to the U.S. Patent Office. Rather, the copy of the Amendment was transmitted at the Examiner's request as a courtesy in order to facilitate the examination of the above-identified application. Applicants request that the December

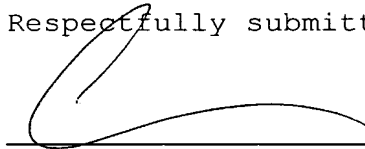
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15, 2003 Notice of Non-Compliant Amendment be withdrawn and that the Examiner enter and consider the April 14, 2003 Amendment In Response to January 14, 2003 Office Action.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

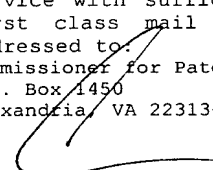
No fee is deemed necessary in connection with the filing of this Communication. However, if a fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White
Registration No. 28,678
Alan J. Morrison
Registration No. 37,399
Attorneys for Applicants
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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450


Alan J. Morrison
Reg. No. 37,399

1/6/07
Date

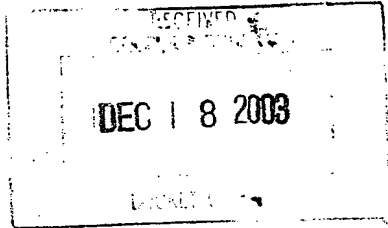


62530-A



UNITED STATES DEPARTMENT OF COMMERCE *JPLW*
U.S. Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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DATE MAILED:

*Response: 1/15/04
MPL*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

The amendment to the claims filed on 9/5/03 does not comply with the requirements of 37 CFR 1.121(c) because there is no listing of all pending claims. Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(c) *Claims.* Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1-5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with

the status of "new" and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

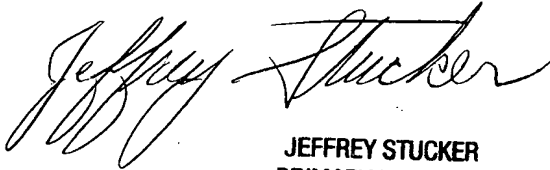
(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number.

Identifying the status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.

Since the reply filed on 9/5/03 appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to submit an amendment in compliance with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

Any inquiry concerning this communication should be directed to Myron G. Hill at telephone number 703-308-4521.



JEFFREY STUCKER
PRIMARY EXAMINER

